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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,159	08/08/2003	J. Mark Weber	065323-0003	2929

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DYKEMA GOSSETT PLLC
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EXAMINER

CHOWDHURY, IQBAL HOSSAIN

ART UNIT	PAPER NUMBER
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1652

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/637,159	WEBER ET AL.	
	Examiner	Art Unit	
	Iqbal H. Chowdhury, Ph.D.	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-23, 27, 30-34, drawn to a method of increasing the production of a biologically active compound in a cell wherein the biologically active compound is derived at least in part from methylmalonyl-CoA, the method comprising the step of inhibiting the activity of methylmalonyl-CoA mutase by reducing said mutase transcription, classified in class 514, subclass 44.

II. Claims 1-23, 28-29, 30-34, drawn to a method of increasing the production of a biologically active compound in a cell wherein the biologically active compound is derived at least in part from methylmalonyl-CoA, the method comprising the step of inhibiting the activity of methylmalonyl-CoA mutase by producing enzymatically inactive said mutase protein, classified in class 435, subclass 6.

III. Claims and 1-23, 24-26, 30-34, drawn to a method of increasing the production of a biologically active compound in a cell wherein the biologically active compound is derived at least in part from methylmalonyl-CoA, the method comprising the step of inhibiting the activity of methylmalonyl-CoA mutase by reducing the coenzyme B12 production by inhibiting cob gene encoding adenosyltransferase transcription, classified in class 435, subclass 86.

The inventions are distinct, each from the other because of the following reasons:

2. The methods of groups I-III are unrelated and patentably distinct. Group I drawn to a method of increasing the production of a biologically active compound in a cell wherein the

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biologically active compound is derived at least in part from methylmalonyl-CoA, the method comprising the step of inhibiting the activity of methylmalonyl-CoA mutase by reducing said mutase transcription. Group II drawn to a method of increasing the production of a biologically active compound in a cell wherein the biologically active compound is derived at least in part from methylmalonyl-CoA, the method comprising the step of inhibiting the activity of methylmalonyl-CoA mutase by producing enzymatically inactive said mutase protein and Group III drawn to a method of increasing the production of a biologically active compound in a cell wherein the biologically active compound is derived at least in part from methylmalonyl-CoA, the method comprising the step of inhibiting the activity of methylmalonyl-CoA mutase by reducing the coenzyme B12 production by inhibiting cob gene encoding adenosyltransferase transcription. Because methods of Groups I-III are unrelated and patentively distinct as they comprise unrelated steps, as use different products and produce different effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. In addition, examining all the groups would require Patent and non-Patent literature databases, which would impose a serious search burden to the Examiner.

This application also contains claims directed to patentably distinct species of biologically active compounds as recited in claims 3, 5, 11 and 13. The biologically active compounds as recited in claims 3, 5, 11 and 13 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions represent structurally different compounds. Therefore, where

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structural identity is required, such as for antibody binding, the different compounds have different effects.

Applicant is required under 35 U.S.C. 121 and 372 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Because these species are distinct for the reasons given above and have acquired a separate status, election of species for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37CFR 1.48b if one or more of the currently named inventors are no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (i).

Applicant is advised the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iqbal H. Chowdhury whose telephone number is 571-272-8137. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Iqbal Chowdhury, PhD, Patent Examiner
Art Unit 1652 (Recombinant Enzymes)
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